

REMARKS/ARGUMENTS

Drawings

The Examiner has objected to the drawings, and in response, Applicant is submitting as part of the Appendix, an "Annotated Sheet Showing Changes", to show redline amendments to Figure 2, and to submit a clean sheet, the "Replacement Sheet" for Figure 2.

The Applicant submits that this fully satisfies the Examiner's objection and requests approval of the drawings.

Amendments to the Specification

Amendments have been made to the specification to make more clear the distinction and difference between the audio output and an audio output device, with no new matter being added.

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 1-34 as being obvious, primarily over Okamoto '631, in view of Van Ryzin '854. The Applicant respectfully requests that the Examiner reconsider the rejections based on the arguments and points submitted below, and where applicable, based on the amendments to the claims submitted above.

The Applicant's arguments and reasons why the Examiner has not met his burden to set forth a *prima facie* case for obviousness, can generally be summarized as follows:

1. There is nothing in the Okamoto '631 patent reference which teaches or suggests that it can or should be combined with Van Ryzin or any other reference which discloses a configuration to receive at least one of AM and FM radio signals.

2. The Okamoto '631 reference is easily user adjustable and directed toward a completely different purpose and different objectives.

3. The combination of references does not include all the elements of the claims in question, there being no promotions or advertisements in the encasements or defined by the encasement in Okamoto or Van Ryzin, but instead the references only include an indication of what station the radio is tuned to, which is required since it can easily be tuned to any one of a number of different stations.

4. The proposed modification to the Okamoto patent renders it unsatisfactory for its intended use, in that Okamoto has a display to show the station it is tuned to, and the information for the display comes from information within the digital signal it is receiving. It is believed that the same information is not contained within an AM or an FM analog signal, and therefore Okamoto would not work as asserted, when combined with the other reference.

5. The proposed modification or combination of Okamoto with Van Ryzin changes

the principle of operation of the digitally based Okamoto, and therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The arguments above apply to each of the independent claims, and therefore to the claims upon which they depend, and therefore the Applicant asserts that all the claims are in a position for allowance.

Applicant requests the Examiner reconsider the rejection because there is nothing in the Okamoto '631 Patent reference which suggests that it be combined with Van Ryzin or any other reference which discloses a configuration to receive at least one of AM and FM radio signals. The Okamoto '631 patent is directed to digital radio and using information which may be placed in the digital signal to identify one of many stations it may be tuned into at a given time.

Furthermore, there is nothing in the Okamoto reference which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

The proposed modification to the Okamoto patent renders it unsatisfactory for its intended use. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The proposed modification to the Okamoto patent renders it unsatisfactory for its intended use, in that Okamoto has a display to show the station it is tuned to, and the information for the display comes from information within the digital signal it is receiving.

It is believed that the same information is not contained within an AM or an FM analog signal, and therefore Okamoto would not work as asserted, when combined with the other reference.

The proposed modification or combination of Okamoto with Van Rycin changes the principle of operation of the digitally based Okamoto, and therefore the teachings of the references are not sufficient to render the claims prima facie obvious. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

New Claims

While the applicant has added several new claims, they are all within the scope of the patent application and the general breadth of the existing claims, no new matter has been added. Applicant submits that new claims 35-53 are similarly distinguishable over the art and should proceed to allowance.

Prior Art Made of Record and Not Relied Upon


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1-53 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 5-13-04

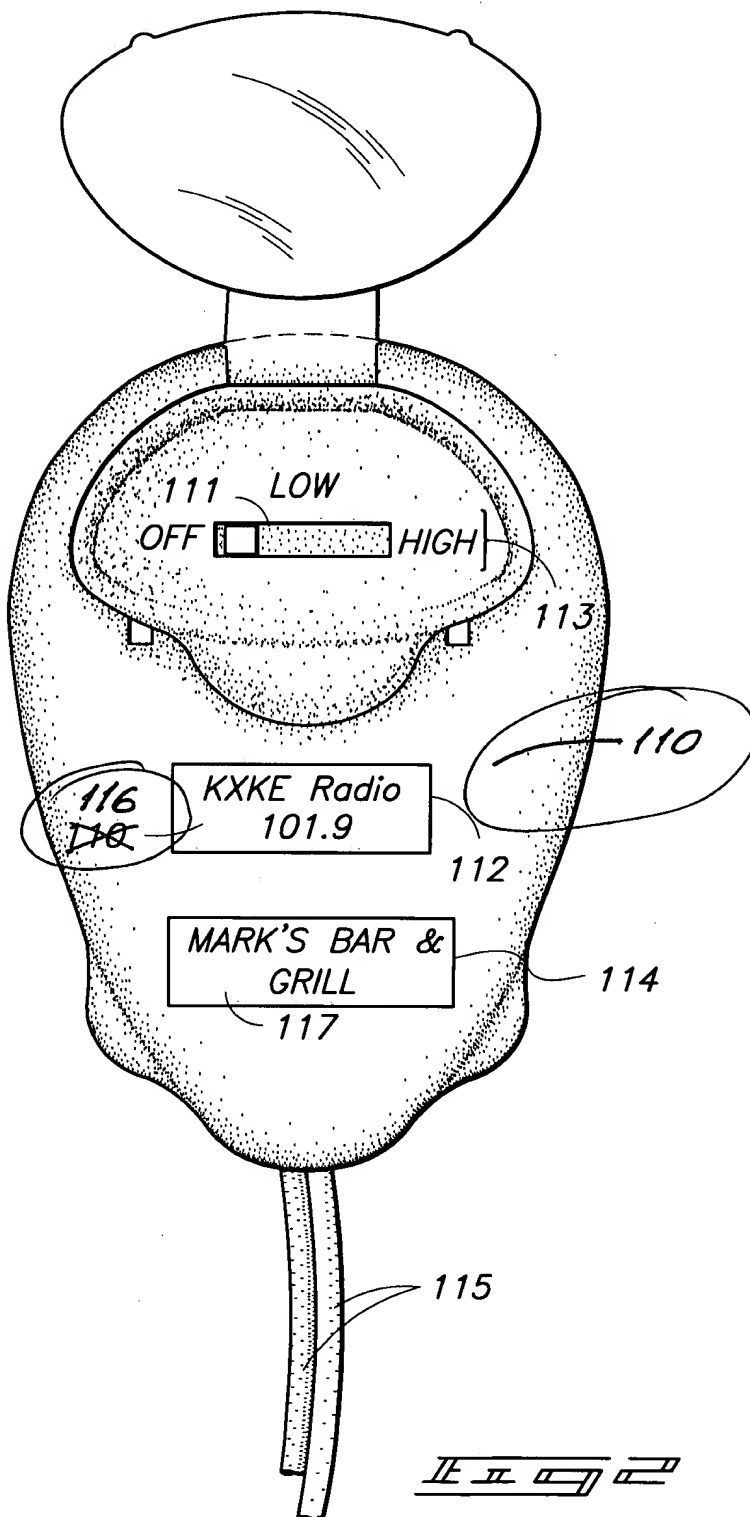
By: 
Mark W. Hendricksen
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Attachments: Replacement Sheet (For Sheet 2, Figure 2)
Annotated Sheet Showing Changes (For Sheet 2, Figure 2.

CANCELLED
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ANNOTATED SHEET SHOWING CHANGES

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